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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/524,411	03/13/2000	Joseph C. Tyler	VSSI-0002	6146

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HOFFMAN WARNICK & D'ALESSANDRO, LLC  
3 E-COMM SQUARE  
ALBANY, NY 12207

EXAMINER
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VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/524,411

**Applicant(s)**

TYLER, JOSEPH C.

**Examiner**

Naresh Vig

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

This is in response to the response received by the office on 03 February 2003 to the office action mailed on 13 August 2002. Amendment to claims 1, 13, 17, 21 and 26 are acknowledged. There are 29 claims, claims 1 – 29 pending for examination.

### ***Response to Arguments***

Applicant's argument that PointCast does not disclose accessing advertising window and selecting advertisement to accompany the story. However, PointCast discloses that it has customization capabilities, and, it offers suite of tools called the "PointCast Intranet Broadcast Solution" for companies (content providers) to create news (title and story, see sample in information on PointCast) and broadcast to the employees (selected group of people). In addition, PointCast allows companies to broadcast internal company news over company's intranet using private PointCast channel. It a business choice on how they decide to create information, and, what messages need to be included in the information. PointCast discloses to display advertisement and news information.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 3, 5 – 7, 10 – 11, 13 – 15, 17 – 19, 21 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering, US Patent 6,216,129 in view of Dedrick, US Patent 5,724,521.

Regarding claims 1 – 2, 5 and 21 – 22, Eldering discloses an advertisement selection system in which vectors describing an actual or hypothetical market for a product or desired viewing audience can be determined. An ad characterization vector is transmitted along with a consumer ID. The consumer ID is used to retrieve a consumer characterization vector which is correlated with the ad characterization vector to determine the suitability of the advertisement to the consumer. The consumer characterization vector describes statistical information regarding the demographics and product purchase preferences of a consumer, and is developed from previous purchases or viewing habits (abstract).

Data to perform the consumer profiling is received from a point of purchase (col 6. lines 33 – 34).

Data structure used to store the information contained in the vector, any of the vectors may be in the form of a table, record, linked tables in a relational database, series of records, or a software object (col. 8, lines 8 – 12). Although, Eldering does not disclose storing information for each website, Eldering discloses that the invention can be used to specify purchasers of a specific product (has means and method to distinguish between products, i.e. can be modified to distinguish between website identification). In a preferred embodiment the advertisement characterization vector contains a description of a target market including an indicator of a target product, i.e., purchasers of a particular product type, brand, or product size. Eldering invention can identify purchasers of a particular brand and can be used to target ads at those consumers to lure them away from their present product provider. Additionally, it is known at the time of invention to a person with ordinary skill in the art that businesses outsource services to save on cost. Therefore, it is known at the time of invention to a person with ordinary skill in the art to make a business decision to offer data collection services for a particular service and collect the data specified by their business customers (what is important to the business customer) to distinct the business from other businesses, and collect information for that business.

A content/opportunity provider maintains the content server which can transmit content including broadcast programming across a network such as the internet (col. 5, lines 27 – 29). Advertiser maintains an ad server which contains a variety of advertisements in the form of still video which can be printed, video advertisements audio advertisements or combinations thereof. The ad demographics vector is used to

target the ad by setting the demographic parameters in the ad demographics vector to correspond to the targeted demographic group.

Eldering does not disclose publisher interface. Dedrick discloses a method and apparatus for providing electronic advertisements to end users in a consumer best-fit pricing manner includes an index database, a user profile database, and a consumer scale matching process. The advertisements can be transferred to multiple yellow page servers, and the titles associated with the advertisements are subsequently transferred to multiple metering servers (abstract). The client system may be provided with tools to create content, advertisements, etc. in the same manner as a publisher/advertiser (col. 3, lines 56 – 59). Therefore, it is known at the time of invention to a person with ordinary skills in the art to provide publisher interface to ensure that the advertisement / messages created are compatible with the system and save on the support cost.

Eldering does not disclose template. However, Eldering discloses sending ads to select consumers. It is known at the time of invention to a person with ordinary skill in the art that mass ad contents are generating by reusing a template to reuse the information. For example, MS Word allows users to merge names into a letter template to create personalized letter (Publishers clearing house is known to send personalized messages).

Regarding claim 3, Eldering discloses that discretionary target market parameters can be specified and do not necessarily need to correspond to an existing

market, but can reflect the various market segments for which the advertisement is targeted. The market segments can be designated by demographic characteristics or by product preferences (col. 3, lines 29 – 34).

Regarding claim 6 and 23 – 24, Eldering discloses that “although FIG. 1A represents content/opportunity provider and content server as being independently connected to internet, with the consumer's devices also being directly connected to the Internet, the content/opportunity provider can also control access to the subscriber. This can occur when the content/opportunity provider is also the cable operator or telephone company. In such instances, the cable operator or telephone company can be providing content to consumer over the cable operator/telephone company access network. As an example, if the cable operator has control over the content being transmitted to the consumer, and has programmed times for the insertion of advertisements the cable operator is considered to be a content/opportunity provider since the cable operator can provide advertisers the opportunity to access consumer by inserting an advertisement at the commercial break” (col. 5 line 54 – col. Line 3).

Regarding claim 7, Eldering discloses that profiler (e.g. publisher) maintains a consumer profile server which contains the characterization of consumer. The consumer profiling system is operated by profiler, who can use consumer profile server

or another computing device connected to consumer profile server to profile consumer  
100 (col. 6, lines 27 – 32).

Regarding claims 10 – 11, Eldering discloses that the content that is being transmitted today is done so in broadcast form, such as broadcast television programming (broadcast over the air and via cable TV networks), broadcast radio, and newspapers. Content can also be broadcast over the Internet and combined with existing video services (col. 5, lines 41 – 53).

Neither Eldering nor Dedrick disclose delivering advertisement over a wireless communication. However, it is known at the time of the invention that advertisers are known to send solicitation over the fax machines and wireless communication devices like beepers. Therefore, it would have been obvious to a person with ordinary skill in the art to include as many advertising mediums as possible to target as many customers as possible.

Claims 4, 8 – 9, 16, 20, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering, US Patent 6,216,129 in view of Dedrick, US Patent 5,724,521, and further in view Paramount's King Island Water and Theme Park hereinafter known as KingsDominion.



Regarding claims 4, neither Eldering nor Dedrick disclose information comprising story content. However, it is known at the time of invention to a person with ordinary skill in the art that advertisers decide on the content of the advertisement to gain most out of the advertisement. For example, in an advertisement for a theme park the main content may be the picture of a thrill ride, whereas, in an advertisement for collecting donations the main content may be a story of someone or something to draw user attention (see information on Kings Dominion).

Regarding claim 8, neither Eldering nor Dedrick disclose contents of the advertisement. However, Kings Dominion discloses to show the map of its park with the list of rides of in the park (to attract visitors of all age groups, see information on Kings Dominion). Therefore, it is known at the time of invention to a person with ordinary skill in the art that advertisers decide on the content of the advertisement to gain most out of the advertisement. For example, in an advertisement for a theme park the main content may be the picture of a thrill ride, calendar showing dates and time the park is open, and map of the location of the theme park.

Regarding claim 9 and 25, neither Eldering nor Dedrick disclose customization of the advertisement. However, Kings Dominion discloses to show the map of its park with

the list of rides of in the park (customized to be seen on a web browser or printed on a paper, see information on Kings Dominion). In addition, theme parks are known to advertise on television showing visitors enjoying on a thrill ride, or, kids enjoying and playing with cartoon characters etc. (customized to show motion video for television). Therefore, it is known at the time of invention to a person with ordinary skill in the art that advertisers customize the advertisement to meet the requirements of the advertising media. For example, advertisement on a printed medium would require the advertisement to fit the physical medium, whereas, the advertisement on a television would require the advertisement customized to meet the time limit, standards (NTSC, PAL) etc. requirements.

Claims 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering, US Patent 6,216,129 in view of Dedrick, US Patent 5,724,521, and further in view of Shear et al., US Patent 6,112,181.

Regarding claim 12, neither Eldering nor Dedrick disclose allowing users to unsubscribe. Shear et al. discloses that a matching and classification utility system comprising a kind of Commerce Utility System used to perform the matching, narrowcasting, classifying and/or selecting. The Matching and Classification Utility system may use any pre-existing classification schemes, including at least some rights

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management information and/or other qualitative and/or parameter data indicating and/or defining classes, classification systems, class hierarchies, category schemes, class assignments, category assignments, and/or class membership (abstract). A customer uses application to subscribe one or more particular classes of content. If a user no longer has an interest in one or more classes, they may also use the same (or similar) application to "unsubscribe " from a particular subject, or specify further narrowing or broadening criteria to adjust the flow of content from one or more classes. Therefore, it is known at the time of invention to a person with ordinary skill in the art to allow customer to unsubscribe from receiving solicitation to avoid lawsuits from customers who do not want solicitations (col. 56, line 57 – col. 57, line 8).

Claims 13 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering, US Patent 6,216,129 in view of Dedrick, US Patent 5,724,521, and further in view of Shear et al., US Patent 6,112,181 and Paramount's King Island Water and Theme Park hereinafter known as KingsDominion.

Claims 26 - 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over PointCast's website "[www.pointcast.com](http://www.pointcast.com)" hereinafter known as PointCast in view of Eldering, US Patent 6,216,129.

Regarding Claim 26 – 29, PointCast discloses system and method for personalized news and information service that uses Internet-connected PCs to broadcast information to its users. PointCast states that "High disposable income and extensive experience shopping online makes PointCast viewers a prime advertising target". PointCast discloses that it can display plurality of windows (news, advertisement, channels etc.) on recipient's computer system (see sample in information on PointCast).

PointCast discloses that it has customization capabilities, and, it offers suite of tools called the "PointCast Intranet Broadcast Solution" for companies (content providers) to create news (title and story, see sample in information on PointCast) and broadcast to the employees (selected group of people). In addition, PointCast allows companies to broadcast internal company news over company's intranet using private PointCast channel.

PointCast does not disclose selecting time of delivery. Eldering discloses that if the cable operator has control over the content being transmitted to the consumer, and has programmed times for the insertion of advertisements the cable operator is considered to be a content/opportunity provider since the cable operator can provide advertisers the opportunity to access consumer by inserting an advertisement at the

commercial break" (col. 5 line 64 – col. Line 3). Therefore, it is known at the time of invention to a person with ordinary skill in the art that advertisements can be transmitted as the selected time of delivery to make the advertisement more effective. For example, sending an advertisement for Christmas decorations in summer may not be as effective as sending the advertisement during holiday season.

Even though, neither PointCast nor Eldering disclose storing information for each website, Eldering discloses that the invention can be used to specify purchasers of a specific product (has means and method to distinguish between products, i.e. can be modified to distinguish between website identification). In a preferred embodiment the advertisement characterization vector contains a description of a target market including an indicator of a target product, i.e., purchasers of a particular product type, brand, or product size. Eldering invention can identify purchasers of a particular brand and can be used to target ads at those consumers to lure them away from their present product provider. Additionally, it is known at the time of invention to a person with ordinary skill in the art that businesses outsource services to save on cost. Therefore, it is known at the time of invention to a person with ordinary skill in the art to make a business decision to offer data collection services for a particular service and collect the data specified by their business customers (what is important to the business customer) to distinct the business from other businesses, and collect information for that business.

PointCast does not disclose using demographics for selection. However, Eldering discloses to support demographics and product purchase preferences of a consumer. In addition, it is known at the time of invention to a person with ordinary skill in the art that

business use demographic data to identify consumer market. Therefore, it is known at the time of invention to a person with ordinary skill in the art to use demographic data to identify consumer market.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Finsterwald US Patent 6,039,244
2. Tai US Patent 4,908,761

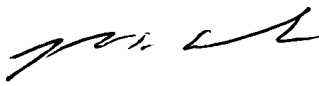
3. An article, Beware What You Leave On The Net ... Someone's Watching
4. An article, E-Mail Direct, Marketing Comes Of Age
5. An article, The Data Issue Heats Up The Internet

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

Naresh Vig  
April 16, 2003

  
**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**